



10.26-96

Patent
Attorney's Docket No. P1630:275

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Max McFarland

Application No.: 08/435,375

Filed: May 5, 1995

For: SYSTEMS AND METHODS FOR
REPLACING OPEN WINDOWS
IN A GRAPHICAL USER
INTERFACE

) BOX AF

) Group Art Unit: 2415

) Examiner: B. Huynh

)

)

)

)

RECEIVED
96 OCT 24 PM 2:49
GROUP: 240

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The following remarks are presented in response to the Office Action dated July 9, 1996. Favorable reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-7 are currently pending.

Applicant wishes to express gratitude for the withdrawal of the rejection under 35 U.S.C. §112, second paragraph, and further would like to express gratitude for the consideration and entry of the proposed drawing changes submitted with the Amendment filed on April 18, 1996.

Claims 1-7 were again rejected under 35 U.S.C. § 103 as allegedly being obvious over Bates et al. Applicant respectfully traverses this rejection for the following reasons.

The Examiner has agreed that the window display order list of Bates et al is a dynamic variable computed on the basis of the extent to which a user has previously used

a window, and thus fails to return a window to its original position as set forth, among other features, in Applicant's claim 1, for example. However, the Examiner asserts that it would have been obvious for one of ordinary skill in the art, at the time the invention was made, upon reading Bates, to implement a window list ordering that is not time variant, and thus return a window to its original position. The Examiner explains the motivation for modifying Bates in this way as "to return the windows to the locations which are already familiar to the users". Applicant respectfully disagrees with the obviousness of this modification for at least two reasons.

First, Applicant respectfully submits that the described motivation for modifying Bates in the manner set forth in the Office Action does not establish a *prima facie* case of obviousness. This is true because the motivation to "return the windows to the locations which are already familiar to the users" can only have blossomed from reading Applicant's specification, since it is clearly not a teaching or suggestion found in the Bates document or any other document of record. Moreover, Applicant requests that the Examiner carefully consider Applicant's contention that Bates in fact teaches away from this type of modification since Bates expressly describes a window display order list which is dynamic. It is noted that the Examiner is basing this ground of rejection on the general proposition that the elimination of an element, when its function is not desired, would have been obvious. This general proposition, however, does not extend to the selective and surgical removal of a small part of a device when such an elimination is only motivated by Applicant's specification, and particularly when the eliminated function is part of the essence of the described technique.

Secondly, even assuming, strictly *arguendo*, that it would have been obvious to modify Bates to implement a window list ordering that is not time variant as suggested in the Office Action, Applicant's claimed combinations still would not have resulted therefrom.

Referencing column 4, lines 29-34 of the Bates patent, the Examiner points out that Bates describes a window display order list that is generated by the computer. The order of window display is dictated by an amount of time that a user interacts with each of the given windows being displayed. The Examiner contends that the teaching of Bates suggests that if window timing is reset after every section [sic], or is permanently deactivated, then the window display order list will remain permanently unchanged and the windows will be displayed at the same position every time the system is started [sic]. Applicant respectfully disagrees with the Examiner's characterizations of Bates regarding the consequences of resetting and deactivating window timing for at least the following reasons.

A careful review of the Bates patent reveals that the windows will not necessarily be returned to an original position when Bates' window timing is reset or deactivated. For example, deactivation of the Bates system is described in the patent text at column 8, lines 54-64, which text refers to process step reference numbers set out in Figure 5C. Referring to Figure 5C, if a turn window timing off event is indicated (i.e., deactivation), an ON/OFF control flag is set to OFF at process step 166. If there are any window records at step 168, the process loops through step 169 where In focus and Total time data are set to zero for each open window. Since the system is turned off, it can only be

assumed that event flags are not generally set, and that the process will flow through steps 170, 175 and 195 before being returned to general window processing through flow connectors F, D and B. As described in Bates at column 7, lines 36-38, following a determination that the ON/OFF control flag is set to OFF, the window timing program ends immediately at block 399. Because the program is shut off, the window reordering function is no longer available to a user. Thus, deactivating the window timing function of Bates would merely have the effect that no window reordering was performed.

With respect to the consequences of the resetting function of Bates, it appears that the Examiner has taken the position that column 6 of Bates teaches that by resetting the window timing, subsequent reordering of the windows will cause the windows to be redrawn in an original order. Applicant notes that the reset function of Bates is intended to be used, for example, when a user is performing a completely unrelated task relative to earlier performed tasks which provides an opportunity for the window timing to "start over". See col. 6, lines 29-35. Bates does not suggest using the reset function whenever the windows are to be reordered, as is apparently alleged by the Examiner.

Moreover, Applicant respectfully submits that by resetting the window timing, the window ordering in Bates will merely continue to be performed in accordance with an active timing indicator recorded for each of the open windows. That is, resetting the timing for the windows does not reset the windows themselves, but only resets the window active *timing* record ("in focus timing") to zero. Thus, Bates simply does not teach or suggest Applicant's claimed step of returning said window to said original

position based upon said list, as set forth, among other steps, in claim 1. Similar comments apply to claims 2-7.

For at least the reasons set forth above, it is respectfully submitted that Applicant's claims 1-7 are not taught or fairly suggested by Bates et al. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. § 103 be reconsidered and withdrawn.

All of the objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions regarding this response or the application in general, he is urged to contact the undersigned to expeditiously resolve the outstanding issues at (703) 838-6642.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: Steven M. du Bois
Steven M. du Bois
Registration No. 35,023

Post Office Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: October 9, 1996